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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,910	03/16/2000	Hoyt A. Fleming, III	108298610US	1414

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EXAMINER
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AL HASHEMI, SANA A

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/526,910

Applicant(s)

FLEMING, III ET AL.

Examiner

Sana Al-Hashemi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 52-62 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

### DETAILED ACTION

1. This is in response to application amendment filed on 9/18/02 in which Claims 1-62 are presented for examination

Claim Status: 1-51 rejected, and 52 –62 have been withdrawn from further consideration.

2. Applicant's arguments filed August 12, 2002 have been fully considered but they are not persuasive.

3. By Originally Presented Claims where claims to another invention are properly added and entered in the application before an action is given, they are treated as original claims for purposes of restriction only.

The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application, and in any request for continued examination (RCE) which has been filed for the application. Subsequently presented claims to an invention other than that acted upon should be treated as provided in MPEP.

Newly submitted claims 52-62 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-51, drawn to audiovisual processing method, classified in class 707, subclass 102.

II. Claims 52-62, drawn to a controlling reproduction, classified in class 707, subclass 104.1.

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Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particular of the subcombination as claimed for Patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(d)). In the instant case, the combination (I) as claimed does not require the particular of the subcombination II as claimed because it is a reproduction controlling method that need not be related to a audiovisual method. The subcombination II has separate utility such as controlling user rating input and reviewing stored data. Therefore, the inventions are distinct. However, they could be usable together.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 52-62 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-13 and 15-51 rejected under 35 U.S.C. 102(e) as being anticipated by Abecassis (US Patent No. 6,304,715)

4. Regarding Claim 1, Abecassis discloses a method of creating a playback database for an audiovisual work comprising the acts of

assigning a respective content ratings level to at least a portion of a scene of work (see column 6, lines 41-44, Abecassis);

creating a database containing information identifying the at least a portion of the scene and the content ratings level(see column 7, lines 21-24, Abecassis);

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storing database on a storage medium different from the medium that stores the audiovisual work (see column 11, lines 31-37, Abecassis).

5. Regarding Claim 2, Abecassis discloses a method wherein assigning act is performed in response to ratings level inputs from a reviewer (see column 7, lines 16-18, Abecassis)

6. Regarding Claim 3, 21, 34, 41 and 46, Abecassis discloses a method wherein act of creating includes creating database containing identifying information which identifies those scenes having content ratings levels which are less than or equal to a predetermined content ratings level (see column 10, lines 13-16, Abecassis).

7. Regarding Claim 4, 35, 42 and 47, Abecassis discloses a method wherein act of creating includes creating database containing identifying information which identifies those scenes having content ratings levels which are greater than a predetermined content ratings level (see column 10, lines 10-13, Abecassis).

8. Regarding Claim 5, Abecassis discloses a method wherein act of creating includes creating a database containing information identifying content ratings levels for all scenes of a work (see column 7, lines 20-26, Abecassis).

9. Regarding Claims 6, 7, 23, 24, 32, 33, 44, 48, and 49 Abecassis discloses a method wherein act of creating includes creating a database that contains data indicating which scenes of work are to/ or not to be reproduced (see column 7, lines 40-62, Abecassis).

10. Regarding Claim 8, Abecassis discloses a method wherein the act of creating includes creating a database containing information identifying at least a portion of the scene by a frame number (see column 10, lines 51-59, Abecassis).

11. Regarding Claim 9, Abecassis discloses a method wherein the act of creating includes

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creating a database containing information identifying at least a portion of the scene by a time stamp (see column 8, lines 34-37, Abecassis).

12. Regarding Claims 10-13, and 26-29 Abecassis discloses a method wherein the act of storing database includes storing said database on a server computer, which allows database to be accessible to client computers (see Fig. 6 step 700, column 11, lines 1-7 Abecassis).

13. Regarding Claim 15, Abecassis discloses a method of controlling reproduction of an audiovisual work comprising the acts of:

accessing a stored database containing information identifying at least a portion of a scene of work having an assigned content ratings level which bears a predetermined relationship to a predetermined content ratings level (see column 9, lines 53-57, Abecassis);

reproducing scenes of work in accordance with at least a portion of a scene which are identified in database (see column 9, lines 58-64, Abecassis).

14. Regarding Claim 16, and 17, Abecassis discloses a method further including reading an audiovisual work from a first and second storage medium (see column 11, lines 52-58, Abecassis).

15. Regarding Claim 18, Abecassis discloses a method wherein the act of accessing comprises establishing a connection to a server containing said database and downloading said database into a controller which controls reproduction of said work, said controller using the information in said database to control reproduction of said work (see column 11, lines 16- 23, Abecassis).

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16. Regarding Claim 19, and 37, Abecassis discloses a method wherein act of accessing includes establishing a connection to an Internet server, whereby connection is an Internet connection (see column 14, lines 1-2, Abecassis).

17. Regarding Claim 20, and 38, Abecassis discloses a method wherein the act of accessing includes establishing a dial-up connection (see column 14, lines 3-4, Abecassis).

18. Regarding Claim 22, Abecassis discloses a method wherein the act of accessing includes accessing a database containing information identifying those scenes having a content ratings level which is greater than predetermined content ratings level (see column 10, lines 10-13, Abecassis).

19. Regarding Claim 25, Abecassis discloses an apparatus for creating a playback database for an audiovisual work comprising:

- a reproduction unit for reproducing scenes of work;

- an input device for assigning a ratings level corresponding to a degree of objectionable content to at least a portion of a scene of said work;

- a device for creating a database containing an identification of the at least a portion of the scene having an assigned content ratings level; and

- a storage medium different from the medium that stores the audiovisual work for storing said database.

20. Regarding Claim 30, Abecassis discloses an apparatus wherein input device receives inputs from a movie reviewer and the database is stored on a storage medium accessible to a work reproduction unit in a household (see column 9, lines 38-43, Abecassis).



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21. Regarding Claim 31, Abecassis discloses an apparatus wherein the database contains ratings level information for all scenes of work (see column 9, lines 53-57, Abecassis).

22. Regarding Claim 36, Abecassis discloses an apparatus for controlling playback of an audiovisual work, apparatus comprising:

a device for accessing a stored database containing an identification of those scenes of work having a content ratings level which bears a predetermined relationship to a predetermined content ratings level (see column 12, lines 12-16, Abecassis);

a reproduction unit for reproducing scenes of work in accordance with scenes which are identified in database.

23. Regarding Claim 39, Abecassis discloses an apparatus wherein the access device includes a controller for controlling the reproduction unit, the controller using the information contained in the database to control reproduction of said work by the reproduction unit (see column 11, lines 15-23, Abecassis).

24. Regarding Claim 40, Abecassis discloses an apparatus wherein the controller is a computer (see column 11, lines 39-44, Abecassis).

25. Regarding Claim 43, Abecassis discloses an apparatus wherein the database contains data indicating which scenes or the work are to be reproduced (see column 8, lines 1-14, Abecassis)

26. Regarding Claim 45, Abecassis discloses a stored information apparatus comprising:

a recording medium; and a database stored on the recording medium, the database containing information identifying scenes of an audiovisual work which have a content ratings level which bears a predetermined relationship to a predetermined content ratings level, the

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identifying information being usable to control an audiovisual reproduction unit to reproduce selected scenes of said audiovisual work (see column 11, lines 1-51, Abecassis).

27. Regarding Claim 50, Abecassis discloses an apparatus wherein the stored information apparatus does not include the audiovisual work (see column 9, lines 53-64, Abecassis).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (US Patent No. 6,304,715).

28. Regarding Claim 14, Abecassis discloses a method of creating a playback database for an audiovisual work comprising the acts of:

assigning a respective content ratings level to at least a portion of a scene of work (see column 9, lines 1-7, Abecassis);

creating a database containing information identifying the at least a portion of the scene and the content ratings level (see column 9, lines 8-12, Abecassis);

Abecassis does not explicitly indicate the step of uploading database to an Internet. However Abecassis discloses the downloading database from an Internet, and since the database is loaded on a disk in the first place before it can be downloaded (see column 14, lines 10-14,

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Abecassis). It would have been obvious to one of ordinary skill in the to upload data to the Internet. The motivation would have been to increase the number of customers purchasing the product and it's easier access for users.

29. Examiner respectfully traverses applicant's primary arguments.

Referring to claim 1, applicant states that the database is stored on a storage medium different from the medium that stores the audiovisual work. Abecassis does disclose the steps of string data on a different storage by downloading program from the Internet user may save it to the buffer of the PC and then can edit the data on a laser videodisk, which is different storage from the medium that stores the audiovisual (see column 12, lines 1-22, Abecassis).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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*Points of Contact*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to: Sana Al-Hashemi whose telephone number is (703) 305-4881. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436. Any response to this office action should be mailed to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231. Or telefax at phone number (703) 746-9098. For formal or draft communications, please label "PROPOSED" or "DRAFT". Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6<sup>th</sup> Floor Receptionist, Arlington, Virginia. 22202.

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October 16, 2002

  
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